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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,936	03/12/1999	PETRI SILENIUS	1562.0110000	6421

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STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/266,936

Applicant(s)

SILENIUS

Examiner

Kevin R Krueer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED July 12, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1,4,7,8,10-16 and 31-34.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Applicant proposed amendment has been entered. The amendment clarifies the claim language but does not change the scope of the claims.

Applicant's arguments have been fully considered but are not persuasive.

Applicant argues that claims 12 and 32 are allowable over the prior art because the prior art fails to teach a method of reducing the wear of a wire that is used in the making of coated, wood-free papers. The examiner respectfully disagrees. The applied art meets every claimed method limitation of claims 12 and 32. The preamble limitation "of reducing wear of a coated, wood-free paper making wire" fails to distinguish the claimed invention from the invention claimed in the prior art because the preamble merely states the purpose or intended use of the invention. MPEP 2111.02 states that a preamble is not considered a limitation and is of no significance to claimed construction when the preamble merely states the purpose or intended use of the invention.

Applicant further argues that the prima facie obviousness is not established for at least the following reasons. (1) There must be a basis in the art for combining or modifying the cited art. Here, the Examiner has pointed to nothing in the cited art that would suggest that wear on the wire that is used in making coated wood-free papers could be reduced by adding calcium oxalate according to the claims. (2) the Examiner has relied on art that teaches how to improve the ashing of cigarette papers. However, improvements in the ashing of cigarette papers are non-analogous art to how to reduce the wear on the wire

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used in the papermaking machine. (3) The cited art does not teach the problem with the wear of the wire that is used to make coated, wood-free paper.

With respect to argument (1), the examiner notes there was motivation for combining the cited art. As noted by Applicant, the motivation relied upon was to improve the ashing of cigarette papers. With respect to argument (2), Applicant's attention is directed to the preceding paragraph. Specifically, it is noted that the preamble limitation does not distinguish the claimed method from the method rendered obvious by the prior art. With respect to argument (3), the examiner notes that the motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.

With respect to the rejection of claims 1, 4, 7, 10, 11, 13-16, 31, 33, and 34, Applicant argues that the prior art fails to render the claimed method obvious. The examiner respectfully disagrees. The preamble limitation "of reducing the combustion residue" fails to distinguish the claimed invention from the invention claimed in the prior art because the preamble merely states the purpose or intended use of the invention. MPEP 2111.02 states that a preamble is not considered a limitation and is of no significance to claimed construction when the preamble merely states the purpose or intended use of the invention.

Applicant further argues that the "improved ashing" taught in Briskin '559 does not mean a "decrease" in the combustion ratio. The examiner agrees, but notes the Briskin was not relied upon to provide such a teaching. Rather, the

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examiner pointed to the disclosure of Briskin'109 to show that paper containing calcium oxalate necessarily would have a lower combustion residue than a paper containing an equivalent amount of calcium carbonate.

Applicant further argues that prima facie obviousness has not established for the following reasons. (1) There must be a basis in the art for combining or modifying the cited art. Here, the Examiner has pointed to nothing in the cited art that would suggest that a decrease in the combustion residue of coated, wood-free papers could be achieved by adding calcium oxalate according to the claims. (2) The Examiner has relied on art that teaches how to improve the ashing of cigarette papers. However, improvements in the ashing of cigarette papers are non-analogous art with regard to a problem of how to reduce the combustion ratio of coated, wood-free papers. (3) The cited art does not teach the problem of the relatively higher combustion ratios that the art finds with coated, wood-free papers. Therefore, the cited art does not suggest the solution. (4) The invention does not require the presence of a black pigment as Hampl does; art is not properly combinable or modifiable if their intended function is destroyed.

With regard to reason (1), the examiner notes that the prior art did provide motivation for combining the teachings of the references. Specifically, the use of calcium oxalate in place of calcium carbonate improves the ashing properties of the paper. With respect to argument (2), Applicant's attention is directed to the preceding paragraph. Specifically, it is noted that the preamble limitation does not distinguish the claimed method from the method rendered obvious by the prior art. With respect to reason (3), the examiner notes that the motivation to

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modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.

With respect to reason (4), it is noted that the features upon which applicant relies (i.e., lack of black pigment) are not recited in the rejected claim(s). Applicant argues that claimed paper is distinguished from the prior art paper because the addition of black pigment reduces the brightness of the prior art paper. However, Hampl teaches that a paper having the claimed brightness can be obtained even when the black pigment is present. Thus, applicant's arguments are not persuasive. Applicant further argues that leaving out the black pigment of Hampl destroys the invention of Hampl. However, the rejection never suggested that the black pigment should be removed from the invention of Hampl. Rather, the rejection took the position that the white pigment could be replaced with calcium oxalate for the purpose of improving the ashing properties of the paper. While Applicant notes that the invention does not require the presence of black pigment such a component is not excluded from the claimed coated wood free paper either. Applicant further argues that there is no teaching in the prior art that the calcium oxalate may be used to readily replace common pigments without any loss of brightness and opacity of the product. However, both calcium oxalate and calcium carbonate are used in the art as white pigments. Thus, one of ordinary skill in the art would assume calcium oxalate

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could be utilized in place of calcium carbonate without a severe drop in the paper's brightness.

With regard to the rejection of claim 8, Applicant argues that none of the cited art suggests particle sizes as recited in the claims. The examiner respectfully disagrees. Rafton teaches that the particle size is a result effective variable that affects the quality of the resulting paper. Thus, the examiner maintains the position that a skilled artisan would have been motivated to optimize the particle size and distribution of the calcium oxalate.

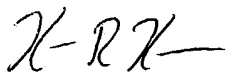
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

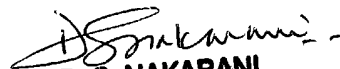
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773


D. S. NAKARANI
PRIMARY EXAMINER